

**REMARKS**

Claims 7-9, 15-17, 23, 31-33, 39, and 41 were pending. Claims 7, 15-17, 23, and 31-33 stand rejected. Claims 1-6, 10-14, 18-22, 24-30, 34-38, and 40 have been cancelled. Claims 7, 15-17, 23, 31, and 39 have been amended to clarify, more particularly point out, and more distinctly claim inventive concepts previously present in these claims. Claims 42 and 43 have been added. Therefore, Claims 7-9, 15-17, 23, 31-33, 39, and 41-43 are pending. Certain amendments do not narrow the scope of the claims, and certain amendments are not required for patentability. Applicant respectfully submits that no new matter has been added by the amendments to the claims. In order to advance prosecution of this Application, Applicant has responded to each notation by the Examiner. Applicant respectfully requests reconsideration and favorable action in this case.

**Claim 39**

Applicant makes note that although the cover sheet of the pending Office Action indicates that Claim 39 is pending, the body of the Office Action indicates that Claim 39 is cancelled. Applicant believes that Claim 39 is pending. Confirmation would be appreciated.

**Objections to Claims**

The Examiner indicated that "Claim 31 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim." Office Action, page 3, paragraph 1. Applicant has amended Claim 31 to place the claim in proper dependent form. Accordingly, Applicant respectfully requests withdrawal of the objection to Claim 31.

Applicant appreciates the indication that "Claims 8, 9, 39, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Office Action, page 6, paragraph 1. Applicant respectfully submits that in view of the amendments and reasons stated herein, rewriting Claims 8, 9, 39, and 41 in independent form is not necessary at this time.

**Section 102 Rejection**

Claims 7 and 15-17 stand rejected under 35 U.S.C. 102(b) as allegedly being unpatentable over U.S. Patent No. 4,878,073 to Hoonsbeen (“*Hoonsbeen*”). Applicant respectfully traverses this rejection for the reasons discussed below. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 7 and 15-17.

**a. Claim 7 is patentable over *Hoonsbeen***

Applicant respectfully submits that *Hoonsbeen* fails to disclose, teach or suggest the combination of elements recited in Applicant’s Claim 7, as amended. Amended Claim 7 recites, in part, “a securing mechanism operable to affix the cover to the identification card, the securing mechanism comprising at least one indentation on the second portion, the indentation operable with the first portion to removably connect the first portion to the second portion.” Amended Claim 7 also recites that “a cavity disposed within the first portion, the cavity operable to receive an item.”

*Hoonsbeen* fails to disclose, teach, or suggest “a securing mechanism operable to affix the cover to the identification card, the securing mechanism comprising at least one ***indentation on the second portion***, the indentation operable with the other of the first and second portions to removably connect the first portion to the second portion,” where there is “***a cavity disposed within the first portion, the cavity operable to receive an item,***” of Claim 7, as amended (emphasis added). Instead, *Hoonsbeen* discloses a “snap-fit connection may be provided by a pair of tits 20c on tongue 20b which are received in spaced holes 11a at the top of side panels 11.” See *Hoonsbeen* at column 2, lines 10-13. *Hoonsbeen* further discloses that the side panels form a recess for receiving an insertable slide. *Id.* at column 1, lines 67-69 to column 2, line 1. *Id.* at Figure 2. Thus, the holes in *Hoonsbeen* are located on a portion of the container which has the recess for receiving the slide. *Id.* at column 1, lines 67-69 to column 2, line 1. *Id.* at column 2, lines 12-13. Therefore, *Hoonsbeen* fails to disclose “a securing mechanism operable to affix the cover to the identification card, the securing mechanism comprising at least one indentation on the second portion, the indentation operable with the other of the first and second portions to removably connect the first portion to the second portion,” of amended Claim 7.

As a result, *Hoonsbeen* fails to recite, either explicitly or inherently, the combination of elements specifically recited in amended Claim 7. Amended Claim 7 is thus allowable for at least this reason.

**b. Claim 16 is patentable over *Hoonsbeen***

Applicant respectfully submits that *Hoonsbeen* fails to disclose, teach or suggest the combination of elements recited in Applicant's Claim 16, as amended. Amended Claim 16 recites, in part, "placing a magnetic stripe on the face of the identification card at a location on the identification card that is separate from a projection of the recess onto the face of the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card."

*Hoonsbeen* fails to disclose, teach, or suggest "placing a magnetic stripe on the face of the identification card at a location on the identification card that is *separate from a projection of the recess onto the face of the identification card*, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card," of amended Claim 16 (emphasis added). *Hoonsbeen* discloses "information retrieval strips 25 and 26 which may be attached to selected portions of the outside of the panels 11 of the container." *Id.* at column 2, lines 15-18. *Hoonsbeen* illustrates that the information retrieval strip is located on an outside face of the container **at the same location of a projection of the recess on that outside face**. *Id.* at Figures 1 and 2. Thus, *Hoonsbeen* fails to disclose "placing a magnetic stripe on the face of the identification card at a location on the identification card that is separate from a projection of the recess onto the face of the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card," of amended Claim 16.

As a result, *Hoonsbeen* fails to recite, either explicitly or inherently, the combination of elements specifically recited in amended Claim 16. Amended Claim 16 is thus allowable for at least this reason.

**c. Claims 15 and 17 are patentable over *Hoonsbeen***

Applicant's dependent Claims 15 and 17 are allowable based on their dependence on independent Claims 1 and 16 and further because they recite numerous additional patentable distinctions over the reference of the rejection. Because Applicant believes they have amply demonstrated the allowability of the independent claims over the reference of the rejection, and to avoid burdening the record, Applicant has not provided additional detailed remarks concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so.

### **Claims 42-43**

Although the Examiner has not had the opportunity to reject new Claims 42-43, Applicant respectfully submits that Claims 42-43 are patentable over *Hoonsbeen*. Applicant notes, for instance, that new Claim 42 recites (among other things) “a securing mechanism operable to affix the cover to the identification card, the securing mechanism comprising at least one indentation on one of the first or second portions, the indentation operable with the other of the first or second portions to removably connect the first portion to the second portion, the at least one indentation being an elongated groove.” Applicant also notes that new Claim 43 recites, in part, “the cavity having a peripheral edge angularly disposed relative to a face of the first portion,” “the second portion having a peripheral edge angularly disposed relative to a face of the second portion,” and “a securing mechanism operable to affix the cover to the identification card, the securing mechanism comprising at least one indentation on the peripheral edge of the cavity or the peripheral edge of the second portion, the indentation operable with the other of the first and second portions removably connect the first portion to the second portion.”

### **Section 103 Rejection**

Claims 23 and 31-33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hoonsbeen* in light of U.S. Patent No. 5,546,144 to Lam et al. (“*Lam*”). Applicant respectfully traverses this rejection for at least the reasons discussed below. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 23 and 31-33.

- 1. The *Hoonsbeen-Lam* combination fails to teach or suggest “a magnetic stripe disposed on the first face of the identification card at a location on the identification card *that is separate from a projection of the recess onto the first face of the identification card*, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card”**

To defeat a patent under 35 U.S.C. § 103, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 706.02(j). Applicant respectfully submits that the combination of *Hoonsbeen* and *Lam* proposed by the Examiner fails to disclose, teach, or suggest, either expressly or inherently, the combination of elements

recited in Applicant's Claim 23, as amended. For example, amended Claim 23 recites, in part, "a magnetic stripe disposed on the first face of the identification card at a location on the identification card that is separate from a projection of the recess onto the first face of the identification card, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card."

Applicant submits that amended Claim 23 is patentable over *Hoonsbeen* in view of *Lam*. *Hoonsbeen* fails to disclose, teach, or suggest the "magnetic stripe disposed on the first face of the identification card at a location on the identification card that is ***separate from a projection of the recess onto the first face of the identification card***, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card," of amended Claim 23 (emphasis added). As discussed in the previous section, *Hoonsbeen* discloses "information retrieval strips 25 and 26 which may be attached to selected portions of the outside of the panels 11 of the container." *Id.* at column 2, lines 15-18. *Hoonsbeen* illustrates that the information retrieval strip is located on an outside face of the container **at the same location of a projection of the recess on that outside face**. *Id.* at Figures 1 and 2. Thus, *Hoonsbeen* fails to disclose, teach, or suggest "a magnetic stripe disposed on the first face of the identification card ***at a location on the identification card that is separate from a projection of the recess onto the first face of the identification card***, the magnetic stripe operable to store information of the issuer of the identification card and of the cardholder of the identification card," of Claims 23, as amended, and 31-33, whether *Hoonsbeen* is considered alone or in combination with *Lam*.

As a result, *Hoonsbeen* fails to recite, either explicitly or inherently, the combination of elements specifically recited in amended Claim 23. Amended Claim 23 is thus allowable for at least this reason.

## **2. *Lam* is non-analogous art**

Even assuming for the sake of argument that *Hoonsbeen* and *Lam* could be considered to disclose each and every limitation of Applicant's claims, which Applicant disputes, the proposed *Hoonsbeen-Lam* combination is improper because *Lam* is not analogous art. The Examiner must determine, with respect to the subject matter at issue, what is analogous art for the purpose of the obviousness analysis. MPEP § 2141.01(a). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a) (citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)). A reference in a different field may be reasonably pertinent only if "it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention when considering his problem." MPEP § 2141.01(a) (citing *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060-1061 (Fed. Cir. 1992)). Since *Lam* does not mention or even remotely allude to an identification card, but instead is an invention "providing a securing apparatus for an article to be scanned in an image scanner," *Lam* is not in Applicant's field of endeavor and could not have "commended itself" to Applicant when considering the problem addressed by Applicant's invention. See *Lam* at column 1, lines 25-26. Thus, *Lam* can not be properly used as a reference against Applicant's claims and these rejections cannot properly be maintained.

## **3. No suggestion or motivation to combine**

Even assuming for the sake of argument that *Hoonsbeen* and *Lam* could be considered to disclose each and every limitation of Applicant's claims and that *Lam* is analogous art, which Applicant disputes, this rejection would be improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Hoonsbeen*, *Lam*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Hoonsbeen* with *Lam* in the manner the Examiner proposes.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. MPEP § 2143.01. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a

whole would have suggested to those of ordinary skill in the art.” MPEP § 2143.01 (citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

In the present case, the Examiner is improperly using Applicant’s disclosure as a blueprint for piecing together various elements of *Hoonsbeen* and *Lam*. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)) (emphasis in original). Thus, the mere fact that the Examiner merely states that the teachings of the references can be combined does not provide the required suggestion to combine.

To reject Claim 23 under the proposed combination of *Hoonsbeen-Lam*, the Examiner has made the conclusory “it would have been obvious” statement. Office Action at page 5, paragraph 4. For example, the Examiner merely states that “it would have been obvious” to make the proposed combination “for providing a mounting platform in which to prevent movement of the inserted picture.” *Id.* The Examiner has presented no evidence, however, that suggests or motivates this combination. It is improper for the Examiner to use hindsight having read the Applicants’ disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claim 23, as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine the cited references.

Furthermore, dependent Claims 31-33 are allowable based on their dependence on independent Claim 23 and further because they recite numerous additional patentable distinctions over the references of the rejection.

**CONCLUSION**


For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Jay Johnson, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6431.

A check in the amount of \$200.00 is enclosed to cover the cost of one additional independent claim. Although applicant believes no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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